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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/560,665

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DAVID WILKINS

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Accenture/Finnegan, Henderson,
Farabow, Garrett & Dunner, LLP
901 New York Avenue
Washington, DC 20001-4413

EXAMINER

OUELLETTE, JONATHAN P

ART UNIT

PAPER NUMBER

3629

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DELIVERY MODE

12/22/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 09/560,665	Applicant(s) WILKINS ET AL.	
	Examiner Jonathan Ouellette	Art Unit 3629	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 August 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,4-7,9-12 and 14-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 4-7, 9-12, and 14-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>20080422, 20080702</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. Claims 1, 2, 4-7, 9-12, and 14-21 remain pending in application 09/560,665.

Claim Rejections - 35 USC § 101

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. **Claims 1, 2, 4, and 5 are rejected under 35 U.S.C. 101 because the independent claims fails to meet the machine-or-transformation test, and therefore, fails to satisfy § 101 requirements.**
3. The machine-or-transformation test is a two-branched inquiry; an applicant may show that a process claim satisfies § 101 either by showing that his claim is tied to a particular machine, or by showing that his claim transforms an article. See Benson, 409 U.S. at 70. Certain considerations are applicable to analysis under either branch. First, as illustrated by Benson and discussed below, the use of a specific machine or transformation of an article must impose meaningful limits on the claim's scope to impart patent-eligibility. See Benson, 409 U.S. at 71-72. Second, the involvement of the machine or transformation in the claimed process must not merely be insignificant extra-solution activity (i.e. saving data in a database and displaying data from a database). See Flook, 437 U.S. at 590.
4. Therefore, because the applicable test to determine whether a claim is drawn to a patent-eligible process under § 101 is the machine-or-transformation test set forth by the Supreme

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Court and clarified herein, and independent Claims 1, 2, 4, and 5 plainly fail that test, the claims are rejected.

5. **Claim 6 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claim 6 is attempting to patent computer data.**
6. First, the claimed data is clearly not a "process" under § 101 because it is not a series of steps. The other three § 101 classes of machine, compositions of matter and manufactures "relate to structural entities and can be grouped as 'product' claims in order to contrast them with process claims." 1 D. Chisum, Patents § 1.02 (1994). The three product classes have traditionally required physical structure or material (such as: "to be used on a computer").
7. "The term machine includes every mechanical device or combination of mechanical device or combination of mechanical powers and devices to perform some function and produce a certain effect or result." Corning v. Burden, 56 U.S. (15 How.) 252, 267 (1854). A modern definition of machine would no doubt include electronic devices which perform functions. Indeed, devices such as flip-flops and computers are referred to in computer science as sequential machines. The claimed data has no physical structure, does not *itself* perform any useful, concrete and tangible result and, thus, does not fit within the definition of a machine.
8. A "composition of matter" "covers all compositions of two or more substances and includes all composite articles, whether they be results of chemical union, or of mechanical mixture, or whether they be gases, fluids, powders or solids." Shell Development Co. v. Watson, 149 F. Supp. 279, 280, 113 USPQ 265, 266 (D.D.C. 1957), *aff'd*, 252 F.2d 861, 116 USPQ 428 (D.C. Cir. 1958). The claimed data is not matter, but a form of energy, and therefore is not a composition of matter.

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9. The Supreme Court has read the term "manufacture" in accordance with its dictionary definition to mean "the production of articles for use from raw or prepared materials by giving to these materials new forms, qualities, properties, or combinations, whether by hand-labor or by machinery." *Diamond v. Chakrabarty*, 447 U.S. 303, 308, 206 USPQ 193, 196-97 (1980) (quoting *American Fruit Growers, Inc. v. Brogdex Co.*, 283 U.S. 1, 11, 8 USPQ 131, 133 (1931), which, in turn, quotes the Century Dictionary). Other courts have applied similar definitions. See *American Disappearing Bed Co. v. Arnaelsteen*, 182 F. 324, 325 (9th Cir. 1910), cert. denied, 220 U.S. 622 (1911). These definitions require physical substance, which the claimed data does not have. Congress can be presumed to be aware of an administrative or judicial interpretation of a statute and to adopt that interpretation when it re-enacts a statute without change. *Lorillard v. Pons*, 434 U.S. 575, 580 (1978). Thus, Congress must be presumed to have been aware of the interpretation of manufacture in *American Fruit Growers* when it passed the 1952 Patent Act.
10. A manufacture is also defined as the residual class of a product. 1 Chisum, § 1.02[3] (citing W. Robinson, *The Law of Patents for Useful Inventions* 270 (1890)). A product is a tangible physical article or object, some form of matter, which data is not. That the other two product classes, machine and composition of matter, require physical matter is evidence that a manufacture was also intended to require physical matter. Data does not fall within either of the two definitions of manufacture. Thus, data does not fall within one of the four statutory classes of § 101.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. **Claims 1, 2, 4, 6, 7, 9, 11, 12, 14-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Polk (US 5,946,669) in view of United States Code governing child support payments, particularly 42 U.S.C. §666(b) and 15 U.S.C §1673 (b).**
4. As per **independent Claims 1, 6, and 11**, Polk discloses a method for providing a network-based child financial support framework for facilitating communication between employers, custodial parents, and non-custodial parents (payment facilitation from non-custodial parent (employee) to employer (collector) to accumulator to custodial parent), abstract, Fig.4), comprising the steps of: (a) maintaining a database including information on a received financial support payment utilizing a network (200); (b) providing general information relating to the financial support payment utilizing the network (Figs.5-7, C9 L34-46, Claims 1-8); and (d) displaying a history associated with the financial support payment (C14 L21-26, C14 L48-50).
5. Although, Polk does disclose (c) calculating a proper amount of the financial support payment (1810, Fig.18; C17 L57-66), wherein a first portion of the profile (payment information – amount, date, etc., C14 L21-30) is received from the user across the network and a second portion of the profile is received from the database (Initiator Database, C14 L35-40; Disbursement Database, C14 L35-57), and wherein the user may change the data in

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the second portion of the profile (C14 L21-57 – once payment is made the Disbursement database (payments made/disbursed - second profile) is updated to reflect historical information).

6. Polk fails to expressly disclose, wherein the financial support payment is based on a profile of a user and based on an amount paid to date from a non-custodial parent, and wherein the profile includes data relating to *at least one of* income, number of children, basic support, insurance premium, child care cost, and additional expenses.
7. However, United States Code governing child support payments discloses wherein the financial support payment is based on a profile of a user and based on an amount paid to date from a non-custodial parent, and wherein the profile includes data relating to *at least one of* income, number of children, basic support, insurance premium, child care cost, and additional expenses (see specific portions cited in rejection issued by the BPAI on 2/28/2007)
8. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included calculating a proper amount of the financial support payment based on a profile of a user and based on an amount paid to date from a non-custodial parent, wherein the profile includes data relating to at least one of income, number of children, basic support, insurance premium, child care cost, and additional expenses, and wherein the user may change the data in the profile, as disclosed by United States Code in the system disclosed by Polk, for the advantage of providing a method for providing a network-based child financial support information site that complies with federal law.
9. Furthermore, Polk fails to expressly disclose providing an interface configured to allow the custodial parent to retrieve tracking information for the financial support payment and a

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plurality of historical financial support payments previously schedules to the custodial parent, said tracking information including payment status, payment amount due, payment amount received, payment date, payment receipt date, payment sent date, payment available withdrawal date, and payment case number, said tracking information further including reasons why a scheduled financial support payment was not dispersed if the scheduled financial support payment has not been received by the custodial parent; and displaying, to the custodial parent via the interface, the retrieved tracking information for the financial support payment and the plurality of historical financial support payments.

10. However, Polk does disclose tracking payment and disbursement information for individual initiators (parents/employees) (C9-10), and wherein the saved information is available to terminal devises (C10, Fig.7), and it would have been obvious to include/provide a plurality of information/data types – as such information types are only found in the nonfunctional descriptive data and are not functionally involved in the steps recited. The child financial support system would be performed regardless of the type of information saved for later *display* to the users. Thus, this descriptive data will not distinguish the claimed invention from the prior art in terms of patentability, *see In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).
11. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included providing an interface configured to allow the custodial parent to retrieve/display information related to financial support payments and histories in the system disclosed by Polk, for the advantage of providing a method for providing a network-based child financial support information site with the ability to increase customer

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service and account reliability by providing the users with the ability to verify and review account transaction information. (See KSR [127 S Ct. at 1739] “The combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.”).

12. As per Claims 2, 7, and 12, Polk and United States Code disclose wherein the network includes the Internet.
13. As per Claims 4, 9, and 14, Polk and United States Code disclose wherein the history includes a date (Polk: Fig.9b), an amount received on the date (Polk: Fig.9b), and a disbursement of the amount received (Polk: 725) to the custodial parent (Polk: recipient 250).
14. Although neither Polk nor United States Code expressly disclose displaying an amount retained of the amount received, it is inherent in the system disclosed by Polk, that if the amount received and the disbursement amount are tracked, then the amount retained is also tracked, because it is a function of the amount received and the disbursement amount.
15. As per new Claims 16, 18, and 20, Polk and United States Code disclose providing an interface configured to allow custodial parent to retrieve information related to the financial support payment and a plurality of historical financial support payments previously scheduled to the custodial parent further comprising determining a status of said information (see rejection of independent claims – receiving/verifying saved information obvious based on teachings of Polk).
16. As per Claims 17, 19, and 21, Polk and United States Code disclose providing an interface configured to allow custodial parent to retrieve information related to the financial support payment and a plurality of historical financial support payments previously scheduled to the

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custodial parent further comprising submitting questions regarding said information and receiving answers to said questions (see rejection of independent claims – receiving/verifying saved information obvious based on teachings of Polk; C10 L33-46, Fig. 7, asking questions and receiving answers – equivalent to requesting and receiving data).

17. **Claims 5, 10, and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Polk (US 5,946,669) in view of United States Code governing child support payments, particularly 42 U.S.C. §666(b) and 15 U.S.C §1673 (b), and further in view of Single Parent Central (www.singleparentcentral.com, Retrieved from Internet Archive Wayback Machine <www.archive.org>, date range: 10/13/1999-1/19/2000).**
18. As per Claims 5, 10, and 15, Polk and United States Code Single Parent Central disclose presenting a plurality of frequently asked questions relating to the financial support payment.
19. However, Single Parent Central discloses a website for helping users with custodial payment processes, to include frequently asked questions (www.singleparentcentral.com).
20. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included presenting a plurality of frequently asked questions relating to the financial support payment, as disclosed by Single Parent Central, in the system disclosed by United States Code, in the system disclosed by Polk, for the advantage of providing a method for providing a network-based child financial support information site with the ability to increase customer service and user friendliness, by providing the user with all information necessary to successful complete the financial support process.

Response to Arguments

21. Applicant's arguments filed 8/14/2008, with respect to Claims 1, 2, 4-7, 9-12, and 14-21, have been fully considered but not persuasive. The rejection will remain as Non-Final, based on the cited prior art and the new grounds of rejection.
22. As per Applicant's arguments, the Applicant is directed to the revised rejection above.

Conclusion

23. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jonathan Ouellette whose telephone number is (571) 272-6807. The examiner can normally be reached on Monday through Thursday, 8am - 5:00pm.
24. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (571) 272-6812. The fax phone numbers for the organization where this application or proceeding is assigned (571) 273-8300 for all official communications.
25. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Office of Initial Patent Examination whose telephone number is (703) 308-1202.

December 20, 2008

/Jonathan Ouellette/

Primary Examiner, Art Unit 3629